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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,886	11/16/2001	Kazuki Matsui	121.1027	7581
21171	7590	03/16/2010		
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER SORKOWITZ, DANIEL M	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 03/16/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/987,886

**Applicant(s)**

MATSUI ET AL.

**Examiner**

DANIEL SORKOWITZ

**Art Unit**

3622

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2/24/10.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 and 19-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

***Notice to Applicant***

This communication is in response to the RCE for application 09/987886 filed 2/24/2010. Claims 13-18 have been examined. Claim 32 has been previously added by Applicant, and has been subject to restriction and has been withdrawn from consideration.

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/24/2010 has been entered.

***Election~Restrictions***

Claim 32 was withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 2/24/10.

The traversal is on the ground(s) that "claim 32 recites claim features based on claims 15 and 16 using a somewhat different wording. Thus, claim 32 is not distinct from claims 13-18." This argument is not found persuasive. Examiner has separated the original claim set into 3 separate and distinct inventions for the reasons set forth in the restriction requirement. Originally filed claims 13-18 are directed towards system for distributing advertising selected by a user. In contrast, previously added claim 32 recites a separate and distinct invention which identifies a method for tailoring an advertisement based on user interest, and further introduces the element of a "virtual social space", not found in elected claims 13-18. The fact that these different inventions would require different fields of search is enough to satisfy the criteria for a serious burden, and therefore, the requirement is still deemed proper.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 1. Claims 13-18 are rejected under 35 U.S.C. 103 (a) as being unpatentable over US Patent Number 5,794,210 to Goldhaber et al. in view of over US Patent Number 5,657,049 to Ludolph et al.**

**Regarding claims 13 and 17-18,** Goldhaber discloses

an advertisement provider unit executed by the processor and displaying, on user terminals, a symbolic image corresponding to the advertisement distributor (figure 11 and figure 13 #304-310, column 18 lines 34-5);  
a display displaying, on the user terminals, an advertisement requesting domain including a section of a user interface for accepting an advertisement distribution reservation (figure 11 and figure 13 #304-310, column 18 lines 34-5, an example given by the cybergold coin on a desktop);

a detector executed by the processor and for detecting that a user has selected at least one symbolic image corresponding to an information provider by clicking the symbolic image to the advertisement requesting

domain; (figure 11 and figure 13 #304-310, column 18 lines 34-5, an example given by the cybergold coin on a desktop);

an advertisement distribution reservation requesting unit executed by the processor and identifying the symbolic image detected with the detector and generating and transmitting distribution reservation requesting data to the advertisement distributor corresponding to the symbolic image (column 9 line 53- 67 and column 10 lines 38-59); and

an information display unit executed by the processor and displaying advertisement information distributed from the advertisement distributor to the user terminal corresponding to the user (column 9 line 53- 67 and column 10 lines 38-59). Goldhaber does not disclose changing and managing the display position of an image in response to a user manipulation by moving dragging and dropping. However, Ludolph discloses detecting, saving, changing, and managing the display position of an image in response to a user manipulation by clicking moving dragging and dropping (figure 9c and figure 10b #220, column 5 line 50-column 6 line 33, column 22 lines 50-65, and column 9 line 53- 67).

Therefore, it would have been obvious to one of ordinary skill at the time of the invention to combine Ludolph's method of icon manipulation including clicking, dragging, and dropping, with the icon selection method of Goldhaber. Moving, Clicking, dragging, and dropping icons to perform tasks such as selecting has been used since before 1984 by the Apple

Macintosh Computer to increase ease of use and fun and enjoyment by the user, e.g. dragging a file to the trash can is easier, more intuitive, and more fun than hitting the delete key.

**Regarding claim 14,** Goldhaber discloses transmitting ad request data to the advertiser corresponding to the relevant symbolic image; and displaying the advertisement (column 9 line 53- 67 and column 10 lines 38-59). Goldhaber further discloses a display displaying, on the user terminals, an advertisement requesting domain including a section of a user interface for accepting an advertisement distribution reservation (figure 11 and figure 13 #304-310, column 18 lines 34-5, an example given by the cybergold coin on a desktop). Goldhaber does not disclose changing and managing the display position of an image in response to a user manipulation. However, Ludolph discloses detecting, saving, changing, and managing the display position of an image in response to a user manipulation (figure 9c and figure 10b #220, column 5 line 50- column 6 line 33 and column 22 lines 50-65). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to combine Ludolph's method of icon manipulation with the icon selection method of Goldhaber, so an advertisement provider display includes a position changing unit changing a display position of a symbolic image in response to a user

manipulation and a management unit managing the display position of the symbolic image for each user, the advertisement distribution reservation requesting unit transmits the distribution reservation requesting data to the advertisement distributor, including the display position of the symbolic image as a selection object, and the information display receives and displays the advertisement information adjusted depending on the display position of the symbolic image transmitted from the advertisement distributor. Moving icons to perform tasks such as selecting has been used since before 1984 by the Apple Macintosh Computer to increase ease of use and fun and enjoyment by the user, e.g. dragging a file to the trash can is easier, more intuitive, and more fun than hitting the delete key.

**Regarding claim 15,** Goldhaber discloses transmitting ad request data to the advertiser corresponding to the relevant symbolic image; and displaying the advertisement (column 9 line 53- 67 and column 10 lines 38-59). Goldhaber further discloses a display displaying, on the user terminals, an advertisement requesting domain including a section of a user interface for accepting an advertisement distribution reservation (figure 11 and figure 13 #304-310, column 18 lines 34-5, an example given by the cybergold coin on a desktop). Goldhaber does not disclose changing and managing the display position of an image in response to a



user manipulation. However, Ludolph discloses detecting, saving, changing, and managing the display position of an image in response to a user manipulation (figure 9c and figure 10b #220, column 5 line 50-column 6 line 33 and column 22 lines 50-65). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to combine Ludolph's method of icon manipulation with the icon selection method of Goldhaber, so the detector detects a position of the symbolic image on the advertisement requesting domain and transmits the position data to the advertisement distribution reservation requesting unit, the advertisement distribution reservation requesting unit transmits the distribution reservation requesting data to the advertisement distributor including the position of the symbolic image on the advertisement requesting domain and said information display displays the advertisement information adjusted depending on the position of symbolic image in the advertisement requesting domain from the information distributor. Moving icons to perform tasks such as selecting has been used since before 1984 by the Apple Macintosh Computer to increase ease of use and fun and enjoyment by the user, e.g. dragging a file to the trash can is easier, more intuitive, and more fun than hitting the delete key.

**Regarding claims 16,** Goldhaber discloses transmitting ad request data to the advertiser corresponding to the relevant symbolic image; and displaying the advertisement (column 9 line 53- 67 and column 10 lines 38-59). Goldhaber further discloses a display displaying, on the user terminals, an advertisement requesting domain including a section of a user interface for accepting an advertisement distribution reservation (figure 11 and figure 13 #304-310, column 18 lines 34-5, an example given by the cybergold coin on a desktop). Goldhaber does not disclose detecting whether other symbolic images already exist in the advertisement requesting domain and also transmits, when the other symbolic images are detected, information relating to the other symbolic images to the advertisement distributor. However, Ludolph discloses detecting, and changing display size of images in a common area based on action to the window as a whole(column 18 lines 25-65). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to combine Ludolph's method of group icon manipulation with the icon selection method of Goldhaber. Selecting all the items in a folder for a common operation is faster than having to select each item separately. Further, Concerning the step of " requesting unit detects whether other symbolic images already exist "; that limitation is optional, and according to the MPEP, "language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a

particular structure does not limit the scope of a claim or claim limitation”  
(MPEP 2106.II. C).

**Regarding claim 17**, Goldhaber discloses an advertiser displaying its image to the users (figure 11 column 18 lines 34-55); displaying, on the user terminals, an icon for requesting an advertisement (figure 11 and figure 13 #304-310, column 18 lines 34-55, an advertisement requesting domain for accepting an advertisement distribution reservation referred to as an icon for requesting an advertisement ); detecting that a user has selected or manipulated an icon to select an ad generating and transmitting ad request data to the advertiser corresponding to the relevant symbolic image; and displaying the advertisement and other images (column 9 line 53- 67 and column 10 lines 38-59).

**Regarding claim 18**, Goldhaber discloses transmitting ad request data to the advertiser corresponding to the relevant symbolic image; and displaying the advertisement (column 9 line 53- 67 and column 10 lines 38-59). Goldhaber further discloses a display displaying, on the user terminals, an advertisement requesting domain including a section of a user interface for accepting an advertisement distribution reservation (figure 11 and figure 13 #304-310, column 18 lines 34-5, an example

given by the cybergold coin on a desktop). Goldhaber does not disclose changing and managing the display position of an image in response to a user manipulation. However, Ludolph discloses detecting, saving, changing, and managing the display position of an image in response to a user manipulation (figure 9c and figure 10b #220, column 5 line 50-column 6 line 33 and column 22 lines 50-65). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to combine Ludolph's method of icon manipulation with the icon selection method of Goldhaber so as to determine whether an icon in which a manipulation is performed corresponds to the symbolic image included in the advertisement information and acquires, positional information relating to the symbolic image as the object of the advertisement information existing in the advertisement requesting domain and also transmits the symbolic image included in the advertisement information and the obtained positional information to the advertisement distribution reservation requesting unit and the advertisement distribution reservation requesting unit also includes a generating unit generating the distribution reservation requesting data based on the symbolic image included in the advertisement information transmitted with the detector and the obtained positional information. Moving icons to perform tasks such as selecting has been used since before 1984 by the Apple Macintosh Computer to increase ease of use and fun and enjoyment by

the user, e.g. dragging a file to the trash can is easier, more intuitive, and more fun than hitting the delete key.

***Response to Remarks/Arguments***

This rejection has been amended to reflect the changes to the claim language and addresses any arguments submitted by the applicant. Therefore, the Examiner maintains the rejection to the Applicant's claims.

Applicant argues regarding restriction requirement that "claim 32 recites claim features based on claims 15 and 16 using a somewhat different wording. Thus, claim 32 is not distinct from claims 13-18." The Examiner disagrees. Examiner has separated the original claim set into 3 separate and distinct inventions for the reasons set forth in the restriction requirement. Originally filed claims 13-18 are directed towards system for distributing advertising selected by a user. In contrast, previously added claim 32 recites a separate and distinct invention which identifies a method for tailoring an advertisement based on user interest, And introduces the element of a "virtual social space", not found in elected claims 13-18. The fact that these different inventions would require different fields of search is enough to satisfy the criteria for a serious burden, and therefore, the requirement is still deemed proper.

Applicant argues regarding claim 18 that "Goldhaber is entirely silent regarding positional information". The cited reference of Ludolph discloses this element. Therefore, Examiner believes the combined references are still a reasonable teaching of the claimed invention in this regard, and the 103 rejection still stands.

Applicant argues regarding claims 14-16 and 18 that "Nothing cited or found in Goldhaber and Ludolph discusses "displays the advertisement information adjusted depending on the display position of the symbolic image transmitted from the advertisement distributor" and " Goldhaber and Ludolph do not discuss "advertisement information adjusted depending on the display position" and "The references are silent regarding the adjustment in advertisement information which is dependent upon on the display position of the symbolic image and thus nothing cited or found teaches "advertisement information adjusted depending on the display position.". The Examiner disagrees. The cited section of Goldhaber teaches displaying advertisement information adjusted depending on the user clicking on the cybercoin icon. The cited section of Ludolph teaches information adjusted depending on its display position. Therefore, Examiner believes the combined references are still a reasonable

teaching of the claimed invention in this regard, and the 103 rejection still stands.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL SORKOWITZ whose telephone number is (571)270-5206. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on 571.272.6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free)? If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D M S/  
Examiner, Art Unit 3622

/Michael Bekerman/  
Primary Examiner, Art Unit 3622